



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,634	06/10/2005	Yasuhito Yuasa	10873.1715USWO	8960
53148 7590 05/22/2008 HAMRE, SCHUMANN, MUELLER & LARSON P.C. P.O. BOX 2902-0902 MINNEAPOLIS, MN 55402				
EXAMINER				
RODÉE, CHRISTOPHER D				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
05/22/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/538,634

**Applicant(s)**

YUASA, YASUHIITO

**Examiner**

Christopher RoDee

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1-24, in the reply filed on 19 September 2007 is acknowledged. Non-elected claims 25-27 have been canceled.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshino *et al.* in US Patent Application Publication 2004/0058258.

This rejection was presented in the last Office action. In response to the rejection, applicants have provided a certified translation of the section 119 priority document (see 37 CFR 1.55). In order for applicants to be entitled to their section 119 priority claim the priority document must describe the claimed invention within the meaning of section 112, first paragraph. See *In re Gosteli*, 10 USPQ2d 1614.

A review of the priority document translation shows that the section 119 document does not disclose the inorganic fine powder as having the polysiloxane and at least one of fatty acids and derivatives thereof adhered. The priority document makes frequent reference to the inorganic powder being "treated" with these compounds or having a surface treatment (document claim 1: ¶¶ [0036], [0042], [0047], [0049], [0050]). There is no disclosure of the polysiloxane and at least one of fatty acids and derivatives thereof adhered to the inorganic oxide.

Art Unit: 1795

The priority document also does not disclose all possible derivatives of fatty acids. The document, as seen in the translation, discloses fatty acid esters, fatty acid amides, and fatty acid metal salts (¶ [0037]) as well as fatty acids (¶ [0042]), but does not disclose any other derivatives as presented in the claims (claims 2 and 13 are properly limited to the disclosed fatty acid derivatives).

Because the Yoshino reference remains valid prior art, the rejection is maintained.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Sugiura *et al.* in US Patent Application Publication 2003/0152857.

This rejection was presented in the last Office action and is incorporated here. Applicants have traversed the rejection because the polysiloxane and at least one of fatty acids and derivatives thereof are not adhered to the inorganic oxide. Applicants have not specified why the process of mixing the components would not inherently result in some of the polysiloxane and at least one of fatty acids and derivatives thereof being adhered to the inorganic oxide. The reference specifically teaches the process of mixing the components is such that 50 % of free silicone oil is obtained (see Example B-9). The remaining silicone oil would appear to be adhered to the silica as the only inorganic oxide present in the mixture and the only component for the silicone oil to reside on. Further, the specification provides no definition of the term "adhered" so the broadest reasonable interpretation would include the situation where the polysiloxane and at least one of fatty acids and derivatives thereof are mixed together to give the desired tensile strength and loose apparent density and these components are in contact with each other. Applicants have not reproduced the example of the reference so that the toner has the characteristics of the document and shown that this product does not meet the requirements of the claims.

The rejection is maintained.

***Claim Rejections - 35 USC § 103***

Claims 12-14, 17, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura *et al.* in US Patent Application Publication 2003/0152857 in view of by Kobayashi *et al.* in US Patent Application Publication 2003/0091923.

Applicants traverse this rejection stating that the rejection is traversed for the same reasons as for Sugiura alone. The traversal is based on the position that the polysiloxane and at least one of fatty acids and derivatives thereof are not adhered to the inorganic oxide. This is not persuasive for claim 12 and those dependent and rejected above because claim 12 only requires the inorganic oxide to be "treated" by the polysiloxane and fatty acid components. Mixing constitutes a treatment giving the term "treated" its broadest and reasonable interpretation.

The rejection is maintained.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura *et al.* in US Patent Application Publication 2003/0152857 in view of "Technical Information TI 1222, Special hydrophobic AEROSIL® (SHA) for Toners", Nippon Aerosil, p. 5.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura *et al.* in US Patent Application Publication 2003/0152857 in view of by Kobayashi *et al.* in US Patent Application Publication 2003/0091923 in view of "Technical Information TI 1222, Special hydrophobic AEROSIL® (SHA) for Toners", Nippon Aerosil, p. 5.

These rejection are traversed for the reasons given for the respective independent claims 1 and 12. The Examiner has fully responded to these traversals and the reasons given

Art Unit: 1795

above for claim 1 are pertinent to claims 4 and 5 and the reasons given for claim 12 are pertinent to claims 15 and 16.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura *et al.* in US Patent Application Publication 2003/0152857 in view of Tyagi *et al.* in US Patent 6,156,473.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura *et al.* in US Patent Application Publication 2003/0152857 in view of by Kobayashi *et al.* in US Patent Application Publication 2003/0091923 further in view of Tyagi *et al.* in US Patent 6,156,473.

These rejection are traversed for the reasons given for the respective independent claims 1 and 12. The Examiner has fully responded to these traversals and the reasons given above for claim 1 are pertinent to claim 10 and the reasons given for claim 12 are pertinent to claim 21.

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura *et al.* in US Patent Application Publication 2003/0152857 in view of Yuasa *et al.* in US Patent Application Publication 2002/0086229.

Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura *et al.* in US Patent Application Publication 2003/0152857 in view of by Kobayashi *et al.* in US Patent Application Publication 2003/0091923 in view of Yuasa *et al.* in US Patent Application Publication 2002/0086229.

These rejection are traversed for the reasons given for the respective independent claims 1 and 12. The Examiner has fully responded to these traversals and the reasons given above for claim 1 are pertinent to claims 7-11 and the reasons given for claim 12 are pertinent to claims 18-22.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 5:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1795

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/  
Primary Examiner  
Art Unit 1795

23 May 2008